

REMARKS / ARGUMENTS

The present application includes pending claims 1-18 and 36-47. Claims 1-3, 5-8, 10, 16-18 and 36-40 are rejected. Claims 41-47 are allowed and claims 4, 9, and 11-15 were objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form. By this Amendment, claims 1, 4, 36, and 39 have been amended, as set forth above, to further clarify the language used in these claims and to further prosecution of the present application. The Applicants respectfully submit that the claims define patentable subject matter.

Claims 1-3, 17-18 and 36-38 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,737,430, issued to Widrow (hereinafter, Widrow), in view of U.S. Patent No. 6,516,075, issued to Jacobs et al. (hereinafter, Jacobs). Claim 5 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Widrow in view of Jacobs and further in view of Valente's "Hearing Aids: Standards, Options, and Limitations, 1996." ("Valente"). Claims 6-8, 10, and 16 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Widrow in view of Jacobs and further in view of U.S. Patent № 6,320,959, issued to Crouch, et al. ("Crouch"). Claims 39-40 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,307,945, issued to Hall ("Hall"), in view of Jacobs.

The Applicants respectfully traverse these rejections at least for the reasons

previously set forth during prosecution and the following remarks.

REJECTION UNDER 35 U.S.C. § 103

In order for a *prima facie* case of obviousness to be established, the Manual of Patent Examining Procedure ("MPEP") states the following:

First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine the teaching. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure.

See MPEP at § 2142, citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991) (emphasis added). Further, MPEP § 2143.01 states that "the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art suggests the desirability of the combination," and that "although a prior art device 'may be capable of being modified to run the way the apparatus is claimed, there must be a *suggestion or motivation in the reference to do so*'" (citing *In re Mills*, 916 F.2d 680, 16 USPQ 2d 1430 (Fed. Cir. 1990)). Moreover, MPEP § 2143.01 also states that the level of ordinary skill in the art cannot be relied upon to provide the suggestion..." citing *Al-Site Corp. v. VSI Int'l*

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Inc., 174 F.3d 1308, 50 USPQ 2d 1161 (Fed. Cir. 1999). Additionally, if a *prima facie* case of obviousness is not established, the Applicant is under no obligation to submit evidence of nonobviousness.

The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.

See MPEP at § 2142.

I. The Proposed Combination of Widrow and Jacobs Does Not Render Claims 1 and 36 Unpatentable

The Applicants now turn to the rejection of claims 1 and 36 as being unpatentable over Widrow in view of Jacobs.

With regard to the rejection of independent claim 1 under 35 U.S.C. § 103(a), the Applicants submit that Widrow and Jacobs do not disclose or suggest at least the limitation of "at least one inductor for converting the second electrical signal into a magnetic field for coupling to at least one telecoil of a hearing aid ... wherein said at least one inductor *comprises a first inductor and a second inductor that is spatially oriented differently from the first inductor*," as recited by the Applicants in independent claim 1. The Office Action refers for support to item 22 of Widrow. See the Office Action at page 2. The Applicants would like to point out that Widrow discloses that the "output of the power amplifier can be used to drive neck loop 9 to generate magnetic flux 22." See Widrow, col. 3, lines 21-23. In this

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regard, item 22 is a magnetic flux and it is not an inductor, as stated by the Examiner's argument in the Office Action. Furthermore, the Applicants submit that item 9 is a neck loop and not an inductor, as recited by the Applicants in claim 1. Also, the neck loop 9 does not comprise a plurality of coils or a plurality of separate inductors, and the Office Action concedes, in page 2, that Widrow does not disclose an inductor comprising a plurality of coils, as recited by the Applicants in claim 1. The Office Action seeks support in Jacobs.

Jacobs discloses an induction coil 12, which is in the form of "a flexible loop which can be draped over the user's shoulder and around his upper body." See Jacobs, col. 2, lines 51-53. Jacobs, therefore, discloses only a single inductive element 12, where an inductance 12a or 12b may be selected depending on the desired number of turns using the switch 46. In this regard, Jacobs does not disclose or suggest a first inductor and a second inductor that is spatially oriented differently from the first inductor, as claimed by the Applicants in claim 1. Therefore, the Applicants submit that claim 1 is allowable.

Independent claim 36 is similar in many respects to the device disclosed in independent claim 1. Therefore, the Applicants submit that independent claim 36 is also allowable over the references cited in the Office Action at least for the reasons stated above with regard to claim 1.

II. Rejection of Dependent Claims 2-3, 17-18, and 36-38

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Based on at least the foregoing, the Applicants believe the rejection of independent claims 1 and 36 under 35 U.S.C. § 103(a) as being unpatentable over Widrow in view of Jacobs has been overcome and request that the rejection be withdrawn. Additionally, claims 2-3, 17-18, and 36-38 depend from independent claims 1 and 36, and are, consequently, also respectfully submitted to be allowable. The Applicants also reserve the right to argue additional reasons beyond those set forth above to support the allowability of claims 1, 2, 17, 18, and 36.

III. Widrow and Jacobs Are Inherently Incompatible and Cannot be Combined

With regard to combining Widrow and Jacobs for purposes of 35 U.S.C. § 103(a) rejections in the Office Action, the Applicants submit that such combination is improper as Widrow and Jacobs are inherently incompatible and a combination of Widrow and Jacobs teaches away from either Widrow or Jacobs when considered individually.

Widrow discloses a neck loop 9 which is used to create inductance but also to support the microphone package 8. Widrow also states that the microphones 3, ..., 7 within package 8 are "*preferably mounted along a horizontal line.*" See Widrow, col. 2, lines 32-33. On the other hand, the induction loop 12 of Jacobs is disclosed for purposes of being worn around the body, as illustrated in Figure 2 of

Jacobs. Therefore, **the neck loop of Widrow and the induction loop belt 12 of Jacobs are clearly performing different and incompatible functions**, i.e., one is to be worn around the neck so as to support a plurality of microphones disposed in a horizontal line (as disclosed by Widrow), and the other is to drape the induction loop belt around a user's upper body so as to support a single microphone (10) and a box (22) in the lowest point of the loop (as disclosed by Jacobs, col. 2, lines 50-58). A combination of Widrow and Jacobs, therefore, would teach away from either one of the two references. In addition, the MPEP clearly states that "it is improper to combine references where the references teach away from their combination." See MPEP 2145.X.D.2 (citing *In re Grasselli*).

The Applicants submit that the combination of Widrow and Jacobs is, therefore, improper and all rejections based on such combination should be withdrawn.

IV. Rejection of Dependent Claim 5-8, 10, and 16

Claim 5 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Widrow in view of Jacobs and further in view of Valente. Claims 6-8, 10, and 16 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Widrow in view of Jacobs and further in view of Crouch. Claims 5-8, 10, and 16 depend from claim 1 and are, consequently, respectfully submitted to be allowable at least for the reasons stated above with regard to claim 1.

The Applicants also reserve the right to argue additional reasons beyond those set forth above to support the allowability of claims 5-8, 10, and 16.

V. Rejection of Claims 39 and 40

Claims 39-40 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,307,945, issued to Hall ("Hall"), in view of Jacobs.

With regard to the rejection of independent claim 39 under Hall and Jacobs, the Applicants submit that the combination of Hall and Jacobs does not disclose or suggest at least the limitation of "at least one inductor for converting the second electrical signal into a magnetic field for coupling to at least one telecoil of a hearing aid ... wherein said at least one inductor comprises a first inductor and a second inductor that is spatially oriented differently from the first inductor," as recited by the Applicants in independent claim 39. The Office Action refers for support to item 7 of Hall. See the Office Action at page 9. The Applicants would like to point out that Hall discloses that "a signal passes into ... the induction loop 7, which passes to a hearing aid ear-piece..." See Hall, col. 5, lines 10-12. In this regard, item 7 is an induction loop, also known in the art as a "neck loop." The Applicants submit that the loop 7 of Hall does not comprise multiple inductors or a plurality of coils, as recited by the Applicants in claim 39. The Office Action concedes, in page 9, that Hall does not disclose an inductor comprising a plurality

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of coils, as recited by the Applicants in claim 39. The Office Action seeks support in Jacobs.

Jacobs discloses an induction coil 12, which is in the form of "a flexible loop which can be draped over the user's shoulder and around his upper body." See Jacobs, col. 2, lines 51-53. Jacobs, therefore, discloses only a single inductive element 12, where an inductance 12a or 12b may be selected depending on the desired number of turns using the switch 46. In this regard, Jacobs does not disclose or suggest a first inductor and a second inductor that is spatially oriented differently from the first inductor, as claimed by the Applicants in claim 39. Therefore, the Applicants submit that claim 39 is allowable.

Additionally, claim 40 depends from independent claim 39, and is, consequently, also respectfully submitted to be allowable. The Applicants also reserve the right to argue additional reasons beyond those set forth above to support the allowability of claims 39-40.

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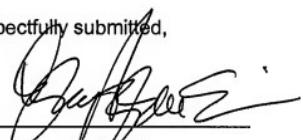
CONCLUSION

Based on at least the foregoing, the Applicants believe that all claims 1-18 and 36-47 are in condition for allowance. If the Examiner disagrees, the Applicants respectfully request a telephone interview, and request that the Examiner telephone the undersigned Attorney at (312) 775-8176.

The Commissioner is hereby authorized to charge any additional fees or credit any overpayment to the deposit account of McAndrews, Held & Malloy, Ltd., Account No. 13-0017.

A Notice of Allowability is courteously solicited.

Respectfully submitted,



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